

**Translation**

**PATENT COOPERATION TREATY**

**PCT**

**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference <b>PL2 03025PCT2-</b>		<b>FOR FURTHER ACTION</b>	See Form PCT/IPEA/416
International application No. <b>PCT/FR2004/000705</b>	International filing date (day/month/year) <b>22.03.2004</b>	Priority date (day/month/year) <b>21.03.2003</b>	
International Patent Classification (IPC) or national classification and IPC			
Applicant <b>SAINT-GOBAIN GLASS FRANCE</b>			

<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>9</u> sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input type="checkbox"/> (sent to the applicant and to the International Bureau) a total of _____ sheets, as follows:</p> <p><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>																									
<p>4. This report contains indications relating to the following items:</p> <table> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. I</td> <td>Basis of the report</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. II</td> <td>Priority</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. III</td> <td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. IV</td> <td>Lack of unity of invention</td> </tr> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. V</td> <td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VI</td> <td>Certain documents cited</td> </tr> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. VII</td> <td>Certain defects in the international application</td> </tr> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. VIII</td> <td>Certain observations on the international application</td> </tr> </table>		<input checked="" type="checkbox"/>	Box No. I	Basis of the report	<input type="checkbox"/>	Box No. II	Priority	<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	<input type="checkbox"/>	Box No. IV	Lack of unity of invention	<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	<input type="checkbox"/>	Box No. VI	Certain documents cited	<input checked="" type="checkbox"/>	Box No. VII	Certain defects in the international application	<input checked="" type="checkbox"/>	Box No. VIII	Certain observations on the international application
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Date of submission of the demand	Date of completion of this report
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

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Box No. I Basis of the report

1. With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language \_\_\_\_\_, which is the language of a translation furnished for the purposes of:
- ☐ international search (Rule 12.3 and 23.1(b))
- ☐ publication of the international application (Rule 12.4)
- ☐ international preliminary examination (Rule 55.2 and/or 55.3)
2. With regard to the **elements** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:
- ☐ the international application as originally filed/furnished
- ☒ the description:
- pages 1-12 \_\_\_\_\_ as originally filed/furnished
- pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- ☒ the claims:
- nos. 1-25 \_\_\_\_\_ as originally filed/furnished
- nos.\* \_\_\_\_\_ as amended (together with any statement) under Article 19
- nos.\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- nos.\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- ☒ the drawings:
- sheets 1/2-2/2 \_\_\_\_\_ as originally filed/furnished
- sheets\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- sheets\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- ☐ a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, nos. \_\_\_\_\_
- ☐ the drawings, sheets/figs \_\_\_\_\_
- ☐ the sequence listing (*specify*): \_\_\_\_\_
- ☐ any table(s) related to sequence listing (*specify*): \_\_\_\_\_
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, nos. \_\_\_\_\_
- ☐ the drawings, sheets/figs \_\_\_\_\_
- ☐ the sequence listing (*specify*): \_\_\_\_\_
- ☐ any table(s) related to sequence listing (*specify*): \_\_\_\_\_

\* If item 4 applies, some or all of those sheets may be marked "superseded."

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

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Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement		
1. Statement			
Novelty (N)	Claims	2-4, 8, 9, 14-23	YES
	Claims	1, 5-7, 10-13, 24	NO
Inventive step (IS)	Claims	2-4, 9, 15, 16, 23	YES
	Claims	1, 5-8, 10-14, 17-22, 24	NO
Industrial applicability (IA)	Claims	1-24	YES
	Claims		NO
2. Citations and explanations (Rule 70.7)			
<p>1. The present report makes reference to the following documents:</p> <p>D1: EP 0 547 327 A (SOMAR CORP) 23 June 1993 (1993-06-23)</p> <p>D2: PATENT ABSTRACTS OF JAPAN, vol. 1998, no. 01, 30 January 1998 (1998-01-30) &amp; JP 09 226007 A (HONDA MOTOR CO LTD), 2 September 1997 (1997-09-02)</p> <p>D3: US 4 264 400 A (BREITMAR PAUL) 28 April 1981 (1981-04-28)</p> <p>D4: US 3 971 691 A (CAIRNS MICHAEL JOHN) 27 July 1976 (1976-07-27)</p> <p>D5: GB-A-2 033 947 (TUOR-HUG V; TUOR-HUG E) 29 May 1980 (1980-05-29).</p> <p>2. The present application fails to satisfy the requirements of PCT Article 33(1) because the subject matter of claim 1 lacks novelty (PCT Article 33(2)). The reasons are the following:</p> <p>2.1 Document D1 describes (the references in brackets are to said document) a method for applying a</p> <p style="text-align: right;">/...</p>			

Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

functional film (figure 1, (1 b)) to at least one part of a surface or of two surfaces of planar or arcuate substrates (figure 1, (6)), the substrates being introduced into a laminating station one at a time such that they are transported thereinto in their planar or mean planar direction, and a film applicator unit with at least one shaft, which is perpendicular to the direction of transport and upon which is mounted a reel (2) of film, the film applicator unit being arranged within the laminating station and the leading edge of the film from each of the reels being introduced into said station (figure 1: (56), (60), (28)) to be applied and fixed to one surface of the substrate at a selected location, the reel(s) of film being unwound to apply the film to the transported substrate in a (single) reel width, the film(s) then being cut (62) at an appointed moment and the new leading edge of film being fixed such that it is ready to be applied at the selected location on the same substrate, or on the following substrate (column 20, lines 46-55), the width of the strip from each reel and the disposition of the reels on the shafts being selected according to the regions of the substrates to be covered by the films.

- 2.2. Documents D2, D3 and D4 also describe production methods that are similar to the subject matter of claim 1.

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Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;  
citations and explanations supporting such statement

3. The present application fails to satisfy the requirements of PCT Article 33(1) because the subject matter of claim 14 does not involve an inventive step (PCT Article 33(3)).

3.1 Document D1 describes a laminating machine for carrying out the method defined in claim 1, the technical features of said machine corresponding to the production method according to claim 1.

3.2 Thus, the laminating machine as per claim 14 differs from the laminating machine described in D1 only in that "the height of the reels can also be adjusted, at least in part".

This technical feature of claim 14 does correspond to one of the process steps of the method according to claim 1.

In view of the optional nature ("can...be adjusted") of this feature and the fact that the feature does not appear to be essential for the implementation of the method according to claim 1 since adjustment of the reel-height is merely optional, said feature is not considered to support an inventive step in the subject matter of claim 14.

3.3 The same arguments apply to documents D2, D3 and D4.

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Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;  
citations and explanations supporting such statement

/...

4. Document D5 describes (the references in brackets are to said document) plates such as windscreens, a functional film being applied to at least one surface thereof in regions defined according to the reel widths (see figures 1 and 2).
- 4.1 The subject matter of claim 24 therefore lacks novelty over D5.
5. Dependent claims 5 to 8, 10 to 13 and 17 to 22 do not contain any features which, combined with the features of any claim to which they refer, meet the PCT requirements for novelty and/or inventive step (PCT Article 33(2) and (3)).

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**Box No. VII**      **Certain defects in the international application**

The following defects in the form or contents of the international application have been noted:

1.      The application does not comply with the requirements of PCT Rule 5.1(a)(ii), because the description does not cite documents D1, D2 or D5 or give a brief outline of those parts of said documents that are relevant to the subject matter of the present application.
  
2.      Independent claim 14 has been duly drafted in the two-part form (PCT Rule 6.3(b)) but the features known in combination from the prior art (documents cited in the search report) have not been included in the preamble (PCT Rule 6.3(b)(i)).

## Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

1. The subject matter of product claim 24 lacks clarity (PCT Article 6) because the plates according to claim 24 are defined in terms of the method used for the production thereof.
  - 1.1 However, since product claims are admissible only if the products *per se* meet the requirements for patentability, that is to say that if they are *inter alia* novel and involve an inventive step (PCT Guidelines, appendix to Chapter 5, paragraph A5.26[1]), which is not the case with regard to claim 24 (see Box V, paragraph 4). Claim 24 should therefore be drafted in such a way as to define the plate in terms of the additional structural features that would distinguish the described plate from the plates described in the prior art.
  - 1.2 In the present case, it is not possible to establish from the plates according to claim 24 whether they have been produced by the method according to one of claims 1 to 13 or by another method. The method according to claim 1 does not impart distinctive technical features to the final product. In consequence, claim 24 fails to comply with the requirements of the Guidelines (see paragraph A5.27) concerning products which cannot be defined in terms of the method by which they are produced.

/...



## Box No. VIII

## Certain observations on the international application

2. Moreover, the subject matter of claim 24 lacks clarity because the expression "applied...in regions defined according to the reel widths" means either that:
- a plurality of reel widths are applied to a plate in a plurality of separate regions
  - or that:
  - reel widths define the contour of a plurality of regions to which the functional film is applied.

The meaning of the above expression is therefore ambiguous.